

### **REMARKS**

Reconsideration of the present application in view of the above claim amendments and the following remarks is respectfully requested.

#### **Status of the Claims**

Claims 11, 13-22 and 25-29 are pending. Claims 11, 15, 25 and 27 are amended to delete the term “biogenic” and insert the corresponding definition therefore, *vide infra*. Support for these amendments is found throughout the specification as originally filed. No claims are cancelled. No new claims have been added.

No new matter has been introduced.

#### **Summary of the Invention as Claimed**

The pending claims as presently amended are directed to cosmetic or dermatopharmaceutical compositions for use in connection with topical application, or to methods of cosmetic treatment of the human body comprising applying to the surface of the human body a composition as now claimed, or to methods of preparing a cosmetic composition. The claims are specifically directed to compositions adapted for use in connection with topical application and require, in addition to the extract of leaves of a *Castanea sativa* plant, at least one cosmetic and/or dermatopharmaceutical auxiliary and/or additive adapted for topical treatment of the human body, selected from a Markush group of such substances. This group includes “biogenic” active ingredients, that is, compounds **produced by living organisms or biological processes**.

**Rejections under 35 U.S.C. § 103(a)**

Previously pending claims 11, 13-14, 20-22 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Withcl (Herbal Drugs and Phytopharmaceuticals: a Handbook for Practice on a Scientific Basis, CRC Press, 1994, pp. 132-133). Applicants respectfully traverse the rejection.

Withcl discloses medicinal uses of *Castanea folium*, Chestnut leaf. A tea is made by either steeping finely cut leaves in boiling water, or boiling the cut leaves in water for a short time, followed by straining. Use of the aqueous extract in medicines, such as antitussives and expectorants, is disclosed.

The Examiner stated that "Withcl beneficially teaches preparing an extract composition from the leaves of *Castanea sativa* via pouring boiling water over finely cut leaves, letting it stand for a short time, passing the water extract solution through a strainer, adding cold water thereto...which is then passed through another strainer (to remove the extract solvent from the leaf material)." (Office Action, page 2, bottom paragraph, through page 3, top paragraph). Applicants aver that this is a misreading of the process disclosed by Withcl. Under the heading "Making the tea", Withcl states the following:

"Boiling water is poured over 2-4 g. of the finely cut leaves and after standing for a short time passed through a tea strainer, **or** cold water is added to the same amount of drug, boiled for a short time, and then strained." (Withcl, page 133, column 3, second paragraph, emphasis added to note separate processes)

Thus, Withcl discloses two distinct methods for "making the tea":

1. pouring boiling water over cut leaves and allowing to steep  
or
2. adding cold water to the cut leaves (referred to as the "drug") and bringing to a boil for a short period of time

Chevallier (Encyclopedia of Herbal Medicine, 2<sup>nd</sup> American edition, DK Publishing, 2000, p. 291; also cited by the Examiner) describes the first process as “infusion” and the second process as “decoction”. One **or** the other would be used in “making the tea”. Therefore the Examiner is mistaken in stating that the process involves a combination of both (i.e., preparing an infusion, straining, **adding cold water, and straining again**). Further, it is unclear how a second **straining** can remove the solvent (it is assumed that this is what is meant by the Examiner’s statement, page 3, top paragraph, “(to remove the extract solvent from the leaf material)” since the “tea leaves” were removed in the first straining). Thus applicants’ at least 2-step process of a) extracting and b) removing the solvent, is not disclosed by Withcl.

Further, the Examiner has interpreted the word “biogenic” to mean “essential for maintaining the fundamental life processes; ‘sleep and food and water are among the biogenic needs of the organism’” based on an online dictionary definition (<http://www.wordreference.com/definition/biogenic>, accessed for purposes of the present reply on February 9, 2010). This may indeed be an appropriate definition for the “biogenic **needs**” of a higher organism; however, applicants aver that this is not the correct definition for a “biogenic active agent” or “biogenic substance”. Such **compounds** are described by the alternate definition provided by the same online dictionary quoted above (website, *vide supra*):

biogenic: “produced by living organisms or biological processes”

Thus, sterols, tocopherols and other vitamins are examples of biogenic compounds which are produced by living organisms or biological processes. Water is certainly not such a compound/molecule.

Therefore, in order to further the present prosecution, applicants have elected to amend the claims to remove the word “biogenic” and replace it with the definition appropriate to the cosmetic and chemical arts, specifically “produced by living organisms or biological processes”. This obviates the Examiner’s rejection, since water is not a compound produced by living organisms or biological processes.

Still further, it is clear that the auxiliaries/additives added to a phytomedicine (specifically disclosed by Withcl to be antitussives and expectorants) are designed to be taken internally to the human body, would not be the same auxiliaries/additives added to a cosmetic or dermatopharmaceutical designed to be administered topically to the body surface, that is, to the skin, hair, or nails. Thus, applicants’ Markush group of cosmetic/dermatopharmaceutical auxiliaries, including such ingredients as pearlescent waxes, oily bodies, superfatting agents, deodorants, antiperspirants, antidandruff agents, insect repellents, perfume oils and the like, would be contraindicated for a phytomedicine to be administered internally, and might well render the composition toxic to the patient.

Finally, taken *in toto*, there is simply no teaching, suggestion or motivation in Withcl that would lead one skilled in the art at the time of the invention to the compositions comprising a *Castanea sativa* leaf extract and at least one auxiliary and/or additive adapted for topical treatment of the human body. Similarly, there is no teaching, suggestion or motivation that would lead one skilled in the art at the time of the invention to methods of cosmetic treatment or methods of preparing a cosmetic composition comprising such a composition.

Accordingly, at least for the above reasons, applicants respectfully submit that the claims as now pending define novel and patentably unobvious subject matter over the cited art.

Previously pending claims 11, 13-22 and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiej (The MacDonald Encyclopedia of Medicinal Plants, MacDonald Publishing, 1984, Plant number 72, *Castanea sativa*) in view of Grand (US 3,849,548), and the state of the art as evidenced by Chevallier (Encyclopedia of Herbal Medicine, 2<sup>nd</sup> American edition, DK Publishing, 2000, pp. 104, 291). Applicants respectfully traverse the rejection.

A full and true reading of Chiej discloses that an infusion or fluid extract of *Castanea sativa* leaves and/or chestnut skins itself serves as a **natural** shampoo (note that the reference does **not** state that the shampoo **comprises** an extract of *Castanea sativa*). Further, the infusions, as evidenced by Chevallier, do **not** include the step of **removing the solvent**, as required by applicants.

Although Chiej teaches that infusions of *Castanea sativa* leaves/nut skins may be used as a **natural** shampoo (that is without any synthetic ingredients added thereto), there is clearly no support in Chiej for inclusion of the one or more auxiliaries and/or additives required by the present claims. Therefore the examiner joined Grand in order to overcome this deficiency in Chiej.

Grand discloses a method of improving the cosmetic condition of the skin or hair, comprising the step of applying thereto a conditioning amount of a composition comprising an aminopolyurea resin in a cosmetic vehicle. The cosmetic vehicle may optionally include "plant extracts". No specific plant is referenced; specifically, Grand is silent concerning *Castanea sativa*.

In view of the deficiencies of Chiej and Chevallier, Grand fails to close the gap. Therefore, the Examiner has failed to establish a prima facie case of obviousness employing the combination of cited references.

Accordingly, at least for the above reasons, applicants respectfully submit that the claims as now pending define novel and patentably unobvious subject matter over the cited art.

### **Conclusion**

In summary, in view of the above claim amendments and remarks, applicants respectfully submit that the invention as now claimed defines subject matter which is patentable over the cited documents. The Examiner is respectfully requested to reconsider, withdraw the finality of the Office Action, withdraw the rejections, and allow the claims.

If any additional fees are required in support of this application, authorization is granted to charge our Deposit Account No. 50-1943.

Respectfully submitted,

Dated: February 16, 2010

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